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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 10/687,228 Confirmation No. 9854  
Appellant : Steven D. Culhane  
Filed : October 16, 2003  
TC/A.U. : 3765  
Examiner : Alissa L. Hoey

Docket No. : 02-200-US2  
Customer No. : 34704

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313

REPLY BRIEF

Sir:

This is in reply to the Examiner's Answer mailed November 14, 2005 setting a two month period for response which expires on January 14, 2006.

**Remarks/Arguments** begin on page 2 of this paper.

## REMARKS/ARGUMENTS

### *(1) The Rejection on Lack of Enablement Fails*

On page 6 of the Examiner's Answer, the Examiner argues that the rejection under 35 U.S.C. 112, first paragraph, is proper because Appellant's specification does not give any suggestion as to what the parameters of "non-stretch". Missing from the Examiner's Answer is the citation of any case law that states that Appellant must provide such parameters. As noted in Appellant's brief and the Appendix D attached thereto, non-stretch fabric materials are well known in the art. It is submitted that Appellant does not need to provide such parameters given the fact that non-stretch fabric materials are well known in the art. Further, the enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation. See *In re Wands*, 858 F.2d 731, 736 - 37, 8 USPQ2d 1400 (Fed. Cir. 1988). The Examiner has not demonstrated that undue experimentation is required to practice the claimed invention. Thus, the rejection under 35 U.S.C. 112, first paragraph, fails.

### *(2) The Rejection of Claims 10 - 13 On Anticipation Grounds Fails*

On page 4 of the Examiner's Answer, the Examiner misstates several features of the Kratz reference. First, the Examiner contends that the arms in Kratz have an outer elbow portion formed from a mesh fabric material. Such statement is not true. As set forth in column 5, lines 48 - 51, elements 92 and 94 are inner elbow portions, not outer elbow portions. Thus, the Examiner is in error when the Examiner says that Kratz anticipates this limitation of claim 10.

Second, the Examiner states that the rear portion having a first and second side portions are formed from a stretch fabric material. Kratz makes no such statement. Nowhere in column 5, lines 17 - 53 does Kratz say that the mesh portions are formed from a stretch material. This is nothing more than an assumption made by the Examiner.

On page 4 of the Examiner's Answer, in the last seven lines, the Examiner discusses certain features that are deemed by the Examiner to be inherent in the cited and applied Kratz reference. It is noted that the Examiner has failed to comply with the legal requirements for establishing inherency. For example, the Examiner has supplied no extrinsic evidence that the artificial leather in Kratz is necessarily made "by a woven base to which a solid and expanded vinyl substance is added making it 'non-stretch'". Further, no extrinsic evidence has been supplied that such a material is necessarily present in Kratz or that one of ordinary skill in the art would recognize it as being present. As noted on page 8 of Appellant's brief, an element of a claim is not inherent in the disclosure of a prior art reference unless extrinsic evidence clearly shows that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. See *in re Robertson*, 159 F.3d 743, 745-46, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999). All the Examiner has presented is a mere possibility or probability. It is submitted that a mere possibility or probability is insufficient to establish inherency. *Id.* The Examiner's statements in the last seven lines of page 4 are nothing more than unsupported assumptions made by the Examiner in an effort to find all the limitations of the claim. The Examiner's interpretation of the reference and what is shown in the drawings is insufficient to establish anticipation. Further, the

Examiner's interpretation finds no support in the written description of Kratz who makes no mention of using stretch and non-stretch materials in the positions set forth in the claims.

On pages 7 and 8 of the office action, the Examiner presents an argument in response to Appellant's argument that Kratz does not anticipate the subject matter of claims 10 and 11 - 13. A review of this argument shows that the Examiner has not identified where in Kratz there can be found any outer elbow portions formed from a stretch fabric material. In fact, the Examiner contradicts the prior argument on page 4 by correctly identifying elbow portions 92 and 94 as being "inner" elbow portions.

With respect to the Examiner's argument in the paragraph bridging pages 7 and 8 of the Examiner's Answer that Kratz does not ever indicate that the mesh portion of the inner elbow is different than that of the shoulder vent, Appellant agrees that this statement is correct. However, it can also be said that Kratz does not ever indicate that the mesh portion of the inner elbow is the same as that of the shoulder vent.

With regard to the Examiner's contention that mesh material due to its construction has stretch, such contention is irrelevant. What is relevant is what the reference says and on this point Kratz is silent. Even if the mesh material does have stretch, there still is no mesh material on an outer elbow portion in the Kratz garment.

With regard to the Examiner's contention on page 8 that the artificial leather of Kratz is less stretchable, this is an assumption or interpretation by the Examiner. Kratz is silent on this point.

(3) *The Rejection of Claims 14 - 16  
Over the Combination of Kratz  
and Blauer et al. fails*

With regard to the Examiner's comments on page 8 regarding the combination of Kratz and Blauer et al., the Examiner provides the exact reason why one of ordinary skill in the art would not combine the two references - namely, the degree of ventilation in Kratz would be affected by incorporating the Blauer et al. liner. Kratz is crystal clear that he wants to provide maximum cooling. See column 2, lines 44 - 46 of Kratz. One could not use the liner of Blauer et al., and still achieve maximum cooling. Whether Blauer et al.'s liner is breathable is irrelevant. The liner without question would severely affect the cooling that could be achieved. The question that would be asked by one of ordinary skill in the art is why does one need the mesh portions if their cooling ability is going to be severely reduced by a liner. It is submitted that one of ordinary skill in the art would not modify Kratz to have the Blauer et al. liner. The mere fact that two structures could be joined together is insufficient to establish obviousness.

(4) *The Rejection of Claims 17 - 19  
Over The Combination of Kratz  
and Lipson Fails*

With regard to the Examiner's arguments in the paragraph bridging pages 8 and 9 of the office action, it is submitted that no motorcycle operator would put a hood over his/her head before a helmet was donned for the purposes of added insulation. For one thing, the hood would likely interfere with the user's ability to put the helmet on his/her head. It is submitted that the motivation to combine set forth by the Examiner can not be found anywhere in the cited and applied prior art. The

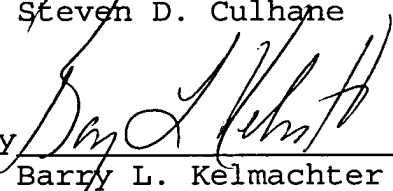
Examiner's motivation statement is nothing more than a fictional reason made up by the Examiner to support the combination of references. This is best demonstrated by the fact that this motivational statement differs from that presented in the final rejection. The claims are allowable for the reasons set forth in Appellant's brief.

(5) *Conclusion*

Claims 10 - 19 are allowable for the reasons set forth herein as well as for the reasons set forth in Appellant's brief. The Board is hereby requested to reverse the rejections of record and remand the application to the Primary Examiner for allowance.

Respectfully submitted,  
Steven D. Culhane

IN TRIPLICATE

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I, Nicole Motzer, hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on January 13, 2006.

